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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/523,287	02/03/2005	Kenji Kogami	SAEG122.002APC	3585

20995 7590 04/24/2007  
KNOBBE MARTENS OLSON & BEAR LLP  
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FOURTEENTH FLOOR  
IRVINE, CA 92614

EXAMINER
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LAMBKIN, DEBORAH C

ART UNIT	PAPER NUMBER
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1626

SHORTENED STATUTORY PERIOD OF RESPONSE	NOTIFICATION DATE	DELIVERY MODE
3 MONTHS	04/24/2007	ELECTRONIC

**Please find below and/or attached an Office communication concerning this application or proceeding.**

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Notice of this Office communication was sent electronically on the above-indicated "Notification Date" and has a shortened statutory period for reply of 3 MONTHS from 04/24/2007.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

jcartee@kmob.com  
eOAPilot@kmob.com

**Office Action Summary**

Application No.

10/523,287

Applicant(s)

KOGAMI ET AL.

Examiner

Deborah C. Lambkin

Art Unit

1626

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 09 December 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-9 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 1-3 and 6-9 is/are allowed.
- 6) ☒ Claim(s) 4 and 5 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

DEBORAH C. LAMKIN  
PRIMARY EXAMINER

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 4 and 5 are rejected under 35 U.S.C. 103(a) as being unpatentable over Cassella Farbwerke et al (CA 88:105153) and/or and/or Bogdanowicz-Szwed et al (CA 136:118356) alone or in combination.

Cassella Farbwerke et al teach the process intermediate, 3-amino-1-(2-thienyl)-2-propen-1-one, for preparing phenoxy-amimopropanols, wherein said intermediate differ from the instant compound by having a H instead of methyl on the nitrogen for the species and alkyl for the genus of C1-C4 alkyl.

Singh et al (CA 115:29157) teach a methyl analog, that is, 3-amino-1-(2-thienyl)-2-buten-1-one of the instant, said methyl analog being a useful intermediate in the preparation of naphthyridinones.

Bogdanowicz-Szwed et al (CA 136:118356) teach a methyl analog, 3-dimethylamino-1-(2-thienyl)-2-propen-1-one, of the instant compound, which is a useful intermediate in the preparation of thiopyrans.

Methyl analogs of known compounds are considered to be obvious variants to the ordinary skilled artisan because of their close structural similarity and therefore expected to produce or possess the same or similar results or properties, absent some unobvious or unexpected results. No unobvious or unexpected side by side comparison

Art Unit: 1626

results are seen over the closest prior art method of record, primarily the N- dimethyl counterpart of the instant N-monoalkyl.

Consequently, the prior art as a whole suggests to one of ordinary skill in the art that a methyl analog of a known compound can produce similar and expected results as their known hydrogen counterpart in the same or similar reaction conditions because they are considered to be obvious variants, wherein the results are predictable.

#### **Notification**

Applicant is hereby notified that in the event that the above claims become allowable, there is a possibility that the instant claims 1-9 be placed in interference with Patent No. US 6,984,738 (Yokozawa et al). Applicant is requested to consider this patent for potential interference.

#### **Allowable Subject Matter**

Claims 1-3 and 6-9 are allowed but pending for potential interference with US Patent 6,984,738.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Deborah C. Lambkin whose telephone number is 571-272-0698. The examiner can normally be reached on M-F 9.00-5.30.

Art Unit: 1626

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Joesph McKane can be reached on 571-272-0699. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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DERORAND LAMBIN  
PRIMARY EXAMINER